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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,560	03/21/2000	NIGEL LAMBERT	TPP30852	6480

7590 08/20/2002

THOMAS P PAVELKO  
STEVENS DAVIS MILLER & MOSHER  
1615 L STREET NW  
SUITE 850  
WASHINGTON, DC 20036

EXAMINER

PADGETT, MARIANNE L

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 08/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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09/463560

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ART UNIT	PAPER NUMBER
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attach to  
16

attach to PTOL-303 - Advisory Action

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Commissioner of Patents and Trademarks

that since the reactive part could be any percentage by weight greater than zero of the coating composition. That one does not know (can't determine) from the claim whether "material" is referring to a monomer, or a resin, or some mixture of compounds, that contain generic functional groups or acrylate groups is a further complication. On page 4 of the response (3rd paragraph), applicant's say that "all compounds must comprise at least three functional acrylate groups", but THERE are NO COMPOUNDS claim just <sup>(generic)</sup> non specific "material".

Concerning the definition of "functionality" discussed on p. 4 of the response, from p. 8 of the specification. The periodic table lists elements (and they don't contain any functional groups, so the "element" in the "definition" must be the generic term, so could mean anything from monomer, resins, compounds and any group mixture thereof, etc., plus the claims discuss generic material not element(s). While "functional group" is not used in the claims, is applicant trying to define it more narrowly than would one of ordinary skill in the art, so that it only include "acrylate groups with C=C double bonds? If so one wouldn't need to list "three functional acrylate groups" separately, however "material" from the claims is not necessarily synonymous with "element" from the definition, and it is unlikely that anyone reading the statement concerning functional groups in context, would equate all functional material in the claims with only or necessarily referring to acrylate groups with C=C bonds. If this is actually what applicants intend, then the confusion can be removed by claiming the specific functional group, rather than generic multi-functional material". At present the record is unclear, and applicant would need to show support for their alleged compounds discussed on p. 4.

MARIANNE PADGETT  
PRIMARY EXAMINER  
GROUP 1700



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DATE MAILED: 16

Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 8/13/02. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

acetone resistance in the claims, as opposed to <sup>all</sup> solvents generally is a new issue.

4. ☒ Applicant's reply has overcome the following rejection(s):  
112 problems with the articles in claims 2 and 4 would be corrected.
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: applicant's interpretation of the claim language "at least 30% by weight" (p. 4 hereinafter)
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1-23
- Claim(s) withdrawn from consideration: \_\_\_\_\_
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☒ Other: PTO attachment

30% by weight..." is not commensurate in scope with the actual claim language.  
As written, the "coating composition" comprises an unknown amount (percentage) of "resin part", which in turn comprises "at least 30% by weight multifunctional material..." which itself comprises an unknown percentage of material (resin, monomer, resin, or what is known) that has at least 3 functional groups. While claim 1, ~~which~~ includes ≤ 30% by wt multifunctional material, it is in NO way limited to groups.